



he hereby certify that this correspondence is being deposited with the  
United States Postal Service as First Class Mail in an envelope  
addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria,  
VA 22313 on 22 June 2006

By: Brian W. Boen

PATENT  
Attorney Docket No. 18072-000610US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of:

STEVEN C. QUAY

Application No.: 10/756,850

Filed: January 13, 2004

For: PRODUCTION AND USE OF  
DERIVATIZED HOMOSERINE  
LACTONES

Examiner: R. Anderson

Art Unit: 1626

**RESPONSE TO RESTRICTION  
REQUIREMENT**

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Restriction Requirement dated June 22, 2006, which set forth the following groups of claims:

I. Claims 109-124, drawn to products of the formulas I wherein R<sup>2</sup> is a reactive functional group, classified in various subclasses of 544, 546 and 548.

II. Claims 109-124, drawn to products of the formulas I wherein R<sup>2</sup> is an alkyl group terminally substituted with a reactive functional group wherein the reactive functional group is a member selected from -OR<sup>3</sup>, -NHR<sup>4</sup>, -COR<sup>5</sup>, -SH and CH<sub>2</sub>X<sup>3</sup>, classified in various subclasses of 544, 546 and 548.

III. Claims 109-124, drawn to products of the formulas I wherein R<sup>2</sup> is an internally substituted alkyl group terminally substituted with a reactive functional group wherein the reactive functional group is a member selected from -OR<sup>3</sup>, -NHR<sup>4</sup>, -COR<sup>5</sup>, -SH and CH<sub>2</sub>X<sup>3</sup>, classified in various subclasses of 544, 546 and 548.

Applicant elects to prosecute Group II, claims 109-124, drawn to products of formulas I wherein R<sup>2</sup> is an alkyl group terminally substituted with a reactive functional group wherein the reactive functional group is a member selected from -OR<sup>3</sup>, -NHR<sup>4</sup>, -COR<sup>5</sup>, -SH and CH<sub>2</sub>X<sup>3</sup> with traverse. Applicant reserves the right to file a divisional or related application to the claims of non-elected groups. Applicant notes that upon an indication of allowability of a generic claim, a reasonable number of additional species will be considered and can be claimed in the same application as provided by 37 CFR §141. Applicant notes that a similar restriction was not required in the parent application, now US 6,703,513.

In addition to an election of one of the above Groups the Examiner has required further restriction under 35 USC § 121 to a single compound. Specifically, the Examiner has required the exact definition of each substitution on the base molecule (Formula I) wherein a single member at each substituent group or moiety is selected.

Applicant respectfully request reconsideration of this request. Applicant does not believe that restriction of the claims to a single embodiment is necessary. In particular, the Examiner has not set forth any particular reason why the Markush groups set forth in the pending claims either (1) do not share a common utility, or (2) do not share a substantial structural structure disclosed as being essential to that utility. The reasoning set forth merely states general statements about the scope of the possible embodiments, but does not relate any reasons why the encompassed scope is relevant to the compositions of the present invention or their use. Further, as above examination of the parent application was carried out without such a restriction indicating that a serious burden does not exist on the Examiner to consider the entire scope of the invention.

As election is required to be responsive, Applicant elects the species wherein R<sup>1</sup> is (=O), R<sup>2</sup> is an alkyl group terminally substituted with a reactive group, wherein the reactive group is NHR<sup>4</sup> (R<sup>4</sup> being hydrogen), X is O, X<sup>1</sup> is O, and X<sup>2</sup> is O. Applicant reserves the right to file a divisional application on any remaining subject matter.

STEVEN C. QUAY  
Application No. 10/756,850  
Page 3

**CONCLUSION**

In view of the foregoing, Applicant believes that all issues raised by the Examiner have been addressed. Further, Applicant believes that all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, please contact the undersigned at 206-467-9600.

Respectfully submitted,

Dated: December 22, 2006

By:   
Brian W. Poor  
Reg. No. 32,928

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Flooor  
San Francisco, CA 94111  
(206) 467-9600  
60945577 v1